Serial No. 09/638,779

Docket: 16705-4906

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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In re application of: LEISLE, Ralph D.	
Serial No.: 09/638,779	Examiner: SHIH, Sally
Filed: August 15, 2000	Group Art Unit: 3624
For: COMPUTER PROGRAM AND METHOD FOR DETERMINING THE ECONOMIC IMPACT OF LONG-TERM CARE	

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APPEAL BRIEF OF THE APPLICANT UNDER 37 C.F.R. § 1.192

COMES NOW Applicant and submits its appeal brief and argument to the U.S. Patent Office Board of Patent Appeals and Interferences under 37 C.F.R. §1.192 to

appeal the Examiner's Final Rejection of Claims 1-27 of U.S. Patent Application Serial No. 09/638,779, filed August 15, 2000 and titled COMPUTER PROGRAM AND METHOD FOR DETERMINING THE ECONOMIC IMPACT OF LONG-TERM CARE. This Brief of the Applicants is filed in triplicate.

(1) Real Party In Interest

This Application is assigned to LTCia, LLC, the Assignment being recorded on August 15, 2000 at Reel No. 011047 and Frame No. 0596. LTCia, LLC is the real party in interest, having a 100% interest in the subject application.

(2) Related Appeals and Interferences

Applicant's attorney is not aware of any related appeals or interferences.

(3) Status of Claims

Claims 1-27 are pending in the application. This is an appeal from the final rejection of Claims 1-27 under 35 USC §102, set forth in the Office Action of Paper No. 11, mailed May 3, 2004. The Claims on appeal are Claims 1-27 and are set forth in full in the Appendix of Claims on Appeal attached hereto and incorporated herein.

(4) Status of Amendments

On December 12, 2003, Applicant submitted an Amendment and Response in response to the Office Action of Paper No. 7, dated September 9, 2003. In

the Amendment and Response, claims 1, 8, 16, 21, 23, and 26 were amended to clarify that the invention pertains to "long-term care insurance options." The Examiner subsequently rejected claims 1-27 in the Office Action of Paper No. 11 under 35 USC §102, and made the rejection Final. No further amendments were made to the Claims.

(5) Summary of the Invention

The invention pertains generally to a computer program and methods for estimating the change in value of a person's estate resulting from the costs associated with receipt of long-term care and impacted by various insurance options chosen and/or not chosen.

One aspect of the preferred embodiment of the present invention is the consideration of tax consequences and other costs such as penalties and transactional fees associated with the liquidation and sale of personal assets to pay long-term care costs (hereinafter referred to generally as tax consequences). Spec. page 3, lines 7-25). The preferred embodiment takes the tax consequences into account when calculating potential economic impacts of long-term care costs by upwardly adjusting the value of personal assets required to be sold to pay such long-term costs. Id.

Another aspect of the preferred embodiment of the invention is the ability to simultaneously generate both an insured hypothetical economic impact and an uninsured hypothetical economic impact on personal assets for any given hypothetical fact scenario. Spec. page 3, lines 26-33. This aspect of the preferred embodiment

allows users to compare the net differences between being insured versus uninsured under any given fact scenario and to weigh risks accordingly. Id.

Yet another aspect of the preferred embodiment of the invention is that the economic impact is determined as a function of time. Spec. page 4, lines 5-23. This aspect of the preferred embodiment allows users to quickly understand how the passage of time influences the hypothetical economic impact of long-term care costs on personal assets. Id.

Additionally, in another aspect of the invention, the determination of the economic impact of long-term care costs includes calculations of unrealized investment opportunity that presumably would have otherwise been realized from assets hypothetically sold to pay long-term care costs and further allows determination of the economic impact at a point in time beyond the time of which care is presumed to be given. Id.

As specified in independent claim 1 on appeal, the invention is directed to a computer program comprising a storage routine that is adapted and configured to store, in a storage device, user-controlled data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options. Spec. page 7, lines 19-26; page 8, lines 10-13. This computer program also comprises a process routine that is adapted and configured for using the stored data to determine an economic impact of the long-term care costs on personal assets. Spec., page 10, lines 14-16. The process routine includes calculations that account for hypothetical tax

consequences resulting from a sale of a portion of the personal assets to pay the long-term care costs. Spec. page 10, line 26-29.

As specified in dependent claim 2, which depends from claim 1, the process routine is adapted and configured to perform calculations that account for hypothetical unrealized investment opportunity resulting from an absence of the portion of the personal assets due to the sale of the portion of the personal assets. Spec. page 10, line 29, to page 11, line 2.

As specified in dependent claim 3, which depends from claim 2, the process routine is adapted and configured to determine the economic impact of the future long-term care costs on the personal assets as a function of time and to output the economic impact for at least a first and second point in time. Spec. page 16, lines 3-6; Figs. 3 and 4.

As specified in dependent claim 4, which depends from claim 3, the second point in time represents a point in time after the long-term care costs have hypothetically ceased being incurred, the economic impact for the second point in time being greater than the economic impact at the time the long-term care costs cease due to the unrealized investment opportunity calculations. Spec. page 11, lines 17-20.

As specified in dependent claim 5, which depends from claim 1, the economic impact represents an insured economic impact and the portion of the personal assets is a first portion. Furthermore, the process routine that is adapted and configured for using the stored data to determine the insured economic impact includes calculations to account for periodic premium payments and monetary insurance benefits received.

Spec. page 12, lines 8-12, and page 15, lines 19-25. The computer program also comprises a process routine that is adapted and configured for using the stored data to determine an uninsured economic impact of the long-term care costs on the personal assets. Spec. page 9, line 32, to page 10, line 2. The process routine that is adapted and configured for using the stored data to determine an uninsured economic impact includes calculations to account for hypothetical tax consequences resulting from a sale of a second portion of the personal assets to pay the long-term care costs. Spec. page 10, lines 4-8. The uninsured economic impact is independent of any periodic premium payments and any monetary insurance benefits received. Spec. page 11, lines 3-8.

As specified in dependent claim 6, which depends from claim 5, the hypothetical tax consequences are accounted for in the process routine that is adapted and configured for using the stored data to determine the insured economic impact by assuming that any long-term care costs in excess of the monetary insurance benefits and all of the insurance premiums are paid for by the sale of the first portion of the personal assets. Spec. page 14, lines 5-13. Additionally, the process routine that is adapted and configured for using the stored data to determine the insured economic impact includes calculations to account for hypothetical unrealized investment opportunity resulting from an absence of the first portion of the personal assets due to the sale the first portion of the personal assets. Spec. page 15, lines 19-28. Furthermore, the process routine that is adapted and configured for using the stored data to determine the uninsured economic impact includes calculations to account for hypothetical unrealized investment opportunity resulting from an absence of the second

portion of the personal assets due to the sale of the second portion of the personal assets. Id.

As specified in dependent claim 7, which depends from claim 5, the program comprises an output routine for facilitating the graphical display of the insured and uninsured economic impacts in a manner allowing proportional visualization of the magnitudes thereof. Spec. page 16, lines 10-12; Fig. 3.

As specified in independent claim 8, the invention is directed to a computer program that comprises a storage routine that is adapted and configured to store, in a storage device, user-controlled data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options. Spec. page 7, lines 19-26; page 8, lines 10-13. The computer program also comprises a process routine that is adapted and configured for using the stored data to determine an insured economic impact of the long-term care costs on personal assets. Spec. page 9, line 32, to page 10, line 2. The process routine that is adapted and configured for using the stored data to determine the insured economic impact includes calculations of a first portion of the personal assets hypothetically sold to pay the long-term care costs and calculations to account for periodic premium payments and monetary insurance benefits received. Spec. page 4, lines 10-17; page 13, lines 13-14; page 12, lines 8-12. The computer program further comprises a process routine that is adapted and configured for using the stored data to determine an uninsured economic impact of the long-term care costs on the personal assets. Spec. page 10, lines 14-16. The process routine that is adapted and configured for using the stored data to determine the uninsured

economic impact includes calculations of a second portion of the personal assets hypothetically sold to pay the long-term care costs. Spec. page 14, lines 7-10. The uninsured economic impact is independent of any periodic premium payments and any monetary insurance benefits received. Spec. page 11, lines 3-8.

As specified in dependent claim 9, which depends from claim 8, the computer program further comprises an output routine for facilitating the graphical display of the insured and uninsured economic impacts in a manner allowing proportional visualization of the magnitudes thereof. Spec. page 16, lines 10-12; Fig. 3.

As specified in dependent claim 10, which depends from claim 8, the process routine that is adapted and configured for using the stored data to determine the insured economic impact includes calculations to account for hypothetical unrealized investment opportunity resulting from the hypothetical sale of the first portion of the personal assets. Spec. page 15, lines 19-28. Additionally, the process routine that is adapted and configured for using the stored data to determine the uninsured economic impact includes calculations to account for hypothetical unrealized investment opportunity resulting from the hypothetical sale of the second portion of the personal assets. Id.

As specified in dependent claim 11, which depends from claim 10, the process routine that is adapted and configured for using the stored data to determine the insured economic impact includes calculations to account for hypothetical tax consequences resulting from the sale of the first portion of the personal assets. Spec. page 10, line 26-29. Additionally, the process routine that is adapted and configured for using the stored data to determine uninsured economic impact includes calculations to account

for hypothetical tax consequences resulting from the sale of the second portion of the personal assets. Id.

As specified in dependent claim 12, which depends from claim 11, the hypothetical tax consequences are accounted for in the process routine that is adapted and configured for using the stored data to determine the insured economic impact by assuming that any long-term care costs in excess of the monetary insurance benefits and all of the insurance premiums are paid for by the sale the first portion of the personal assets. Spec. page 14, lines 5-13.

As specified in dependent claim 13, which depends from claim 11, the process routine that is adapted and configured for using the stored data to determine the uninsured economic impact determines the uninsured economic impact as a function of time and is configured to output the uninsured economic impact for at least first and second points in time. Spec. page 16, lines 3-6; Figs. 3 and 4. Similarly, the process routine that is adapted and configured for using the stored data to determine the insured economic impact determines the insured economic impact as a function of time and is configured to output the insured economic impact for at least the first and the second points in time. Spec. page 10, lines 14-16; Figs. 3 and 4.

As specified in dependent claim 14, which depends from claim 13, the second point in time represents a point in time after the long-term care costs have hypothetically ceased being incurred, the insured and uninsured economic impacts for the second point in time is greater than the insured and uninsured economic impacts respectively at

the time the long-term care costs cease due to the unrealized investment opportunity calculations. Spec. page 11, lines 17-20.

As specified in dependent claim 15, which depends from claim 13, the program further comprises an output routine for facilitating graphical display of the insured and uninsured economic impacts in a manner allowing proportional visualization of the magnitudes thereof. Spec. page 16, lines 10-12; Fig. 3.

As specified in independent claim 16 on appeal, the invention is directed to a computer program comprising a storage routine that is adapted and configured to store, in a storage device, user-controlled data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options. Spec. page 7, lines 19-26, and page 8, lines 10-13. The computer program further comprises a process routine that is adapted and configured for using the stored data to determine an economic impact of the future long-term care costs on personal assets as a function of time and to output the economic impact for at least first and second points in time. Spec. page 16, lines 3-6; Figs. 3 and 4. The process routine is also configured to calculate a portion of the personal assets hypothetically sold to pay the long-term care costs at each of the points in time. Spec. page 4, lines 10-17; page 10, lines 16-22.

As specified in dependent claim 17, which depends from claim 16, the economic impact represents an insured economic impact and each portion of the personal assets is a first portion. Spec. page 9, line 32, to page 10, line 2. Additionally, the process routine that is adapted and configured for using the stored data to determine the insured

economic impact includes calculations to account for periodic premium payments and monetary insurance benefits received. Spec. page 12, lines 8-12, and page 15, lines 19-25. The computer program also comprises a process routine that is adapted and configured for using the stored data to determine an uninsured economic impact of the long-term care costs on the personal assets as a function of time. Spec. page 16, lines 3-6. The process routine that is adapted and configured for using the stored data to determine the uninsured economic impact is configured to output the uninsured economic impact for at least the first and second points in time and to calculate a second portion of the personal assets hypothetically sold to pay the long-term care costs at each of the points in time. Spec. page 10, lines 4-8; page 10, lines 14-22. The uninsured economic impact is independent of any periodic premium payments and any monetary insurance benefits received. Spec. page 11, lines 3-8.

As specified in dependent claim 18, which depends from claim 17, the process routine that is adapted and configured for using the stored data to determine the insured economic impact includes calculations to account for hypothetical tax consequences resulting from the sale of the first portion of the personal assets. Spec. page 10, lines 26-29. Additionally, the process routine that is adapted and configured for using the stored data to determine the uninsured economic impact includes calculations to account for hypothetical tax consequences resulting from the sale of the second portion of the personal assets. Id.

As specified in dependent claim 19, which depends from claim 18, the hypothetical tax consequences are accounted for in the process routine that is adapted

and configured for using the stored data to determine the insured economic impact by assuming that any long-term care costs in excess of the monetary insurance benefits and all of the insurance premiums are paid for by the sale of the first portion of the personal assets. Spec. page 14, lines 5-13.

As specified in dependent claim 20, which depends from claim 18, the process routine that is adapted and configured for using the stored data to determine the insured economic impact includes calculations to account for hypothetical unrealized investment opportunity resulting from the sale of the first portion of the personal assets. Spec. page 15, lines 19-28. Additionally, the process routine that is adapted and configured for using the stored data to determine the uninsured economic impact includes calculations to account for hypothetical unrealized investment opportunity resulting from the sale of the second portion of the personal assets. Id.

As specified in independent claim 21 on appeal, the invention is directed to a method comprising a step of acquiring user-controlled data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options. Spec. page 7, lines 19-26; page 8, lines 10-13. The method also includes a step of determining an economic impact of the long-term care costs on personal assets based on the acquired data. Spec. page 10, lines 14-16. The determination includes performing calculations to account for hypothetical tax consequences resulting from a sale of a portion of the personal assets to pay the long-term care costs. Spec. page 10, lines 26-29.

Dependent claim 22, which depends from claim 21, is directed to a method of advising a person comprising using the method of claim 21 in an effort to persuade the person to purchase long-term care insurance. Spec. page 16, lines 23-33; page 17, lines 21-23.

As specified in independent claim 23 on appeal, the invention is directed to a method comprising a step of acquiring user-controlled data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options. Spec. page 7, lines 19-26; page 8, lines 10-13. The method also includes a step of determining an insured economic impact of the long-term care costs on personal assets based on the acquired data. Spec. page 9, line 32, to page 10, line 2. The determination of the insured economic impact includes performing calculations of a first portion of the personal assets hypothetically sold to pay the long-term care costs and calculations to account for periodic premium payments and monetary insurance benefits received. Spec. page 4, lines 10-17; page 13, lines 13-14; page 12, lines 8-12. Furthermore, the method comprises a step of determining an uninsured economic impact of the long-term care costs on the personal assets based on the acquired data. Spec. page 10, lines 14-16. The determination of the uninsured economic impact including performing calculations of a second portion of the personal assets hypothetically sold to pay the long-term care costs. Spec. page 14, lines 7-10. The uninsured economic impact is independent of any periodic premium payments and any monetary insurance benefits received. Spec. page 11, lines 3-8.

As specified in dependent claim 24, which depends from claim 23, the steps of determining an insured economic impact and of determining an uninsured economic impact are generally made simultaneously. Spec. page 5, lines 29-33; page 15, line 25, to page 16, line 1.

Dependent claim 25, which depends from claim 23, is directed to a method of advising a person comprising using the method of claim 23 in an effort to persuade the person to purchase long-term care insurance. Spec. page 16, lines 23-33; page 17, lines 21-23.

As specified in independent claim 26 on appeal, the invention is directed to a method comprising a step of acquiring user-controlled data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options. Spec. page 7, lines 19-26; page 8, lines 10-13. The method also comprises a step of determining an economic impact of the future long-term care costs on personal assets as a function of time based on the stored data. Spec. page 4, lines 5-23. The determination of the economic impact includes performing calculations of a portion of the personal assets hypothetically sold to pay the long-term care costs for at least first and second points in time. Spec. page 16, lines 3-6; Figs. 3 and 4.

Dependent claim 27, which depends from claim 26, is directed to a method of advising a person comprising using the method of claim 26 in an effort to persuade the person to purchase long-term care insurance. Spec. page 16, lines 23-33; page 17, lines 21-23.

It should be appreciated that the references to pages of the specification and drawing figures herein are exemplary of where support for the described invention can be found. However, support for the described invention is not necessarily limited to such specific references.

(6) Issues on Appeal

A. Whether the Examiner incorrectly concluded that claims 1-27 are anticipated by U.S. Patent No. 6,430,542 issued to Moran (hereinafter Moran).

(7) Grouping of Claims

Claim 1 stands alone as an independently patentable claim with respect to the issues involved in this Appeal.

Claim 2 stands alone with respect to the issues involved in this appeal; this claim is allowable for the same reasons as claim 1 and, as explained below, is allowable for additional reasons.

Claims 3 and 4 stand or fall with claim 2.

Claim 5 stands alone with respect to the issues involved in this appeal; this claim is allowable for the same reasons as claim 1 and, as explained below, is allowable for additional reasons.

Claim 6 stands alone with respect to the issues involved in this appeal; this claim is allowable for the same reasons as claims 1 and 5 and, as explained below, is allowable for additional reasons.

Claim 7 stands alone with respect to the issues involved in this appeal; this claim is allowable for the same reasons as claims 1 and 5 and, as explained below, is allowable for additional reasons.

Claim 8 stands alone as an independently patentable claim with respect to the issues involved in this Appeal.

Claim 9 stands alone with respect to the issues involved in this appeal; this claim is allowable for the same reasons as claim 8 and, as explained below, is allowable for additional reasons.

Claim 10 stands alone with respect to the issues involved in this appeal; this claim is allowable for the same reasons as claim 8 and, as explained below, is allowable for additional reasons.

Claim 11 stands alone with respect to the issues involved in this appeal; this claim is allowable for the same reasons as claims 8 and 10 and, as explained below, is allowable for additional reasons.

Claim 12 stands alone with respect to the issues involved in this appeal; this claim is allowable for the same reasons as claims 8, 10, and 11 and, as explained below, is allowable for additional reasons.

Claim 13 and 14 stand or fall with claim 11.

Claim 15 stands alone with respect to the issues involved in this appeal; this claim is allowable for the same reasons as claims 8, 10, and 11 and, as explained below, is allowable for additional reasons.

Claim 16 stands alone as an independently patentable claim with respect to the issues involved in this Appeal.

Claim 17 stands alone with respect to the issues involved in this appeal; this claim is allowable for the same reasons as claim 16 and, as explained below, is allowable for additional reasons.

Claim 18 stands alone with respect to the issues involved in this appeal; this claim is allowable for the same reasons as claims 16 and 17 and, as explained below, is allowable for additional reasons.

Claim 19 stands alone with respect to the issues involved in this appeal; this claim is allowable for the same reasons as claims 16,17, and 18 and, as explained below, is allowable for additional reasons.

Claim 20 stands alone with respect to the issues involved in this appeal; this claim is allowable for the same reasons as claims 16, 17, and 18 and, as explained below, is allowable for additional reasons.

Claims 21 and 22 generally include the limitations set forth in the arguments presented with respect to claim 1, albeit as method steps. Thus, for purposes of this appeal, claims 21 and 22 stand or fall with claim 1.

Claims 23, 24, and 25 generally include the limitations set forth in the arguments presented with respect to claim 8, albeit as method steps. Thus, for purposes of this appeal, claims 23, 24 and 25 stand or fall with claim 8.

Claims 26 and 27 generally include the limitations set forth in the arguments presented with respect to claim 16, albeit as method steps. Thus, for purposes of this appeal, claims 26 and 27 stand or fall with claim 16.

The foregoing claim grouping is solely for purposes of this appeal and is not an admission that the claims would be grouped the same for any rejections other than the present rejections of claims.

(8) <u>Arguments on Patentability</u>

Legal precedent clearly establishes that "an anticipation rejection requires a showing that each limitation of the claim must be found in a single reference, practice, or device." *In re Donohue*, 226 USPQ 619, 621 (Fed. Cir. 1985). Furthermore, "[f]or a prior art reference to anticipate, every element of the claimed invention must be *identically* shown in a single reference." *In re Bond*, 15 USPQ 2d 1566, 1567-68 (Fed. Cir. 1990) (*emphasis added*). However, in rejecting claims 1-27, the Examiner has failed to address the specific limitations of each claim. As discussed below, particular limitations are clearly not disclosed in Moran, and therefore the anticipation rejections of claims 1-27 is improper and should be withdrawn.

<u>(a) Claim 1 is Not Anticipated by Moran</u>

(i) Independent claim 1 is drawn to a computer program. Claim 1 requires, among other things, that the computer program comprise a storage routine that is adapted and configure to store data indicative of a hypothetical scenario of future long-term care costs and a long-term care insurance option. Moran pertains generally

to a computer program for general estate planing and fails to either explicitly or inherently disclose any long-term care insurance option. Because Moran fails to disclose this limitation, Moran fails to anticipate claim 1 under 35 USC §102.

(ii) Claim 1 also requires that the computer program comprise a process routine that is adapted and configured to utilize the long-term care insurance option to determine the economic impact of long-term care costs on personal assets. The computer program disclosed in Moran calculates various estate values but does not utilize any long-term care insurance option to calculate an economic impact of long-term care costs on personal assets. For this additional reason, Moran fails to anticipate claim 1 under 35 USC §102.

(iii) Claim 1 further requires the process routine to include calculations to account for hypothetical tax consequences resulting from a sale of a portion of the personal assets to pay the long-term care costs. Moran discloses that taxes can be a factor influencing a calculated estate value but does not disclose or suggest any calculation of taxes incurred by the sale of a portion of personal assets to pay long-term care costs. For this additional reason, Moran fails to anticipate claim 1 under 35 USC §102.

(b) Claim 2 is Not Anticipated by Moran

Claim 2 is dependant upon claim 1 and, for all the reasons set forth in section 8(a) above, is therefore not anticipated by Moran. Additionally, claim 2 requires the process routine to be adapted and configured to perform calculations that account for hypothetical unrealized investment opportunity resulting from an absence of the portion

of the personal assets due to the sale of the portion of the personal assets. Thus, when calculating the economic impact, the computer program of claim 2 takes into account future unrealized earnings that would have been made from invested assets, if such assets had not been sold. Moran pertains to calculations of estate values under various scenarios, but not economic impacts on estate values. Thus, for the purposes of the program disclosed in Moran, a calculation of unrealized investment opportunity is irrelevant. As such, Moran neither explicitly nor inherently discloses calculations that account for hypothetical unrealized investment opportunity resulting from an absence of the portion of the personal assets due to the sale of the portion of the personal assets, and therefore does not anticipate claim 2 under 35 USC §102.

(c) Claim 5 is Not Anticipated by Moran

Claim 5 is dependant upon claim 1 and, for all the reasons set forth in section 8(a) above, is therefore not anticipated by Moran. Additionally, claim 5 requires a process routine that is adapted and configured to determine an insured economic impact and that includes calculations to account for periodic premium payments and monetary insurance benefits received. While Moran discloses insurance as factor influencing the value of an estate, it nonetheless fails to disclose or suggest a process routine for determining an insured economic impact that includes any periodic monetary insurance benefits received. For this additional reason, Moran fails to anticipate claim 5 under 35 USC §102.

(d) Claim 6 is Not Anticipated by Moran

Claim 6 is dependant upon claims 1 and 5 and, for all the reasons set forth in sections 8(a) and 8(c) above, is therefore not anticipated by Moran.

(i) Additionally, claim 6 requires the hypothetical tax consequences to be accounted for in the process routine that determines the insured economic impact by assuming that any long-term care costs in excess of the monetary insurance benefits and all of the insurance premiums are paid for by the sale of the first portion of the personal assets. Moran fails to disclose any calculations wherein it is assumed that insurance premiums are paid for by the sale of assets. Thus, Moran fails to disclose or suggest any program or method wherein insurance premium payments have adverse tax consequences. For this additional reason, Moran fails to anticipate claim 6 under 35 USC §102.

(ii) Claim 6 further requires that the determination of the insured economic impact includes calculations to account for hypothetical unrealized investment opportunity resulting from an absence of portions of the personal assets due to the sale of such portions of the personal assets. This limitation is similar to the limitation discussed above in section 8(b) and, for the reasons discussed above in section 8(b), Moran fails to disclose this limitation. For this additional reason, Moran fails to anticipate claim 6 under 35 USC §102.

(e) Claim 7 is Not Anticipated by Moran

Claim 7 is dependant upon claims 1 and 5 and, for all the reasons set forth in sections 8(a) and 8(c) above, is therefore not anticipated by Moran. Claim 7 further

requires an output routine for facilitating the graphical display of the insured and uninsured economic impacts in a manner allowing proportional visualization of the magnitudes thereof. Moran fails to disclose any output routine the facilitates proportional visualization of insured and uninsured economic impacts of long-term care costs on personal assets. Thus, for this additional reason, Moran fails to anticipate claim 7 under 35 USC §102.

(f) Claim 8 is Not Anticipated by Moran

Independent claim 8 is directed to a computer program comprising a storage routine that is adapted and configured to store data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options. This limitation is similar to the limitation of claim 1 discussed above in section 8(a)(i). Therefore, for the same reasons discussed above in section 8(a)(i), claim 8 is not anticipated by Moran under 35 USC §102.

Claim 8 also requires the computer program to comprise a process routine that is adapted and configured for using the long-term care insurance option to determine an insured economic impact of the long-term care costs on personal assets. This limitation is similar to the limitation of claim 1 discussed above in section 8(a)(ii). Therefore, for the same reasons discussed above in section 8(a)(ii), claim 8 is further not anticipated by Moran under 35 USC §102.

Furthermore, claim 8 requires a process routine to include calculations of a first portion of the personal assets hypothetically sold to pay the long-term care costs and calculations to account for periodic premium payments and monetary insurance benefits

received. This limitation is similar to the limitation of claim 5 discussed above in section 8(c). Therefore, for the same reasons discussed above in section 8(c), claim 8 is further not anticipated by Moran under 35 USC §102.

(g) Claim 9 is Not Anticipated by Moran

Claim 9 is dependant upon claim 8 and, for all the reasons set forth in section 8(f) above, is therefore not anticipated by Moran. Claim 9 further requires the computer program to comprise an output routine for facilitating the graphical display of the insured and uninsured economic impacts in a manner allowing proportional visualization of the magnitudes thereof. This limitation is similar to the limitation of claim 7 discussed above in section 8(e). Therefore, for the same reasons discussed above in section 8(e), claim 9 is further not anticipated by Moran under 35 USC §102.

(h) Claim 10 is Not Anticipated by Moran

Claim 10 is dependant upon claim 8 and, for all the reasons set forth in section 8(f) above, is therefore not anticipated by Moran. Additionally, claim 10 requires the computer program to comprise process routines that includes calculations to account for hypothetical unrealized investment opportunity resulting from the hypothetical sale of portions of the personal assets. This limitation is similar to the limitation of claim 2 discussed above in section 8(b). Therefore, for the same reasons discussed above in section 8(b), claim 10 is further not anticipated by Moran under 35 USC §102.

(i) Claim 11 is Not Anticipated by Moran

Claim 11 is dependant upon claims 8 and 10 and, for all the reasons set forth in sections 8(f) and 8(h) above, is therefore not anticipated by Moran. Additionally, claim

11 requires the computer program to include a process routine that include calculations to account for hypothetical tax consequences resulting from the sale of portions of personal assets to pay long-term care costs. This limitation is similar to the limitation of claim 1 discussed above in section 8(a)(iii). Therefore, for the same reasons discussed above in section 8(a)(iii), claim 11 is further not anticipated by Moran under 35 USC §102.

(j) Claim 12 is Not Anticipated by Moran

Claim 12 is dependant upon claims 8, 10, and 11 and, for all the reasons set forth in sections 8(f), 8(h), and 8(i) above, is therefore not anticipated by Moran. Additionally, claim 12 requires the hypothetical tax consequences to be accounted for by assuming that any long-term care costs in excess of the monetary insurance benefits and all of the insurance premiums are paid for by the sale a portion of the personal assets. This limitation is similar to the limitation of claim 6 discussed above in section 8(d). Therefore, for the same reasons discussed above in section 8(d), claim 12 is further not anticipated by Moran under 35 USC §102.

(k) Claim 15 is Not Anticipated by Moran

Claim 15 is dependant upon claims 8, 10, and 11 and, for all the reasons set forth in sections 8(f), 8(h), and 8(i) above, is therefore not anticipated by Moran. Additionally, claim 15 requires the computer program to have an output routine for facilitating graphical display of the insured and uninsured economic impacts in a manner allowing proportional visualization of the magnitudes thereof. This limitation is similar to the limitation of claim 7 discussed above in section 8(e). Therefore, for the same

reasons discussed above in section 8(e), claim 15 is further not anticipated by Moran under 35 USC §102.

(l) Claim 16 is not Anticipated by Moran

Independent claim 16 is directed to a computer program comprising a storage routine that is adapted and configured to store data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options. This limitation is similar to the limitation of claim 1 discussed above in section 8(a)(i). Therefore, for the same reasons discussed above in section 8(a)(i), claim 16 is not anticipated by Moran under 35 USC §102.

Claim 16 also requires the computer program to comprise a process routine that is adapted and configured for using the long-term care insurance option to determine an insured economic impact of the long-term care costs on personal assets. This limitation is similar to the limitation of claim 1 discussed above in section 8(a)(ii). Therefore, for the same reasons discussed above in section 8(a)(ii), claim 16 is further not anticipated by Moran under 35 USC §102.

(m) Claim 17 is Not Anticipated by Moran

Claim 17 is dependant upon claim 16 and, for all the reasons set forth in section 8(l) above, is therefore not anticipated by Moran. Additionally, claim 17 requires the computer program to comprise a process routine that is adapted and configured for using the stored data to determine the insured economic impact including calculations to account for periodic premium payments and monetary insurance benefits received. This limitation is similar to the limitation of claim 5 discussed above in section 8(c).

Therefore, for the same reasons discussed above in section 8(c), claim 17 is further not anticipated by Moran under 35 USC §102.

(n) Claim 18 in Not Anticipated by Moran

Claim 18 is dependant upon claims 16 and 17 and, for all the reasons set forth in sections 8(l) and 8(m) above, is therefore not anticipated by Moran. Additionally, claim 18 requires the process routines to include calculations to account for hypothetical tax consequences resulting from the sale of portions of the personal assets to pay long-term care costs. This limitation is similar to the limitation of claim 1 discussed above in section 8(a)(iii). Therefore, for the same reasons discussed above in section 8(a)(iii), claim 18 is further not anticipated by Moran under 35 USC §102.

(o) Claim 19 is Not Anticipated by Moran

Claim 19 is dependant upon claims 16, 17, and 18 and, for all the reasons set forth in sections 8(l), 8(m), and 8(n) above, is therefore not anticipated by Moran. Additionally, claim 19 also requires the hypothetical tax consequences to be accounted for by assuming that any long-term care costs in excess of the monetary insurance benefits and all of the insurance premiums are paid for by the sale of the first portion of the personal assets. This limitation is similar to the limitation of claim 6 discussed above in section 8(d)(i). Therefore, for the same reasons discussed above in section 8(d)(i), claim 19 is further not anticipated by Moran under 35 USC §102.

(p) Claim 20 is Not Anticipated by Moran

Claim 20 is dependant upon claims 16, 17, and 18 and, for all the reasons set forth in sections 8(l), 8(m), and 8(n) above, is therefore not anticipated by Moran.

Additionally, Claim 20 requires a process routine that includes calculations to account for hypothetical unrealized investment opportunity resulting from the sale of portions of the personal assets to pay the long-term care costs. This limitation is similar to the limitation of claim 2 discussed above in section 8(b). Therefore, for the same reasons discussed above in section 8(b), claim 20 is further not anticipated by Moran under 35 USC §102.

(9) Conclusion

For the reasons set forth above, it is respectfully submitted that Claims 1-27 are allowable over U.S. Patent No. 6,430,542. It is respectfully requested that the rejections of these claims be reversed and the claims allowed.

An oral hearing is not requested.

Respectfully submitted,

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Appendix of Claims on Appeal

1. A computer program comprising:

a storage routine adapted and configured to store, in a storage device, user-controlled data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options; and

a process routine adapted and configured for using the stored data to determine an economic impact of the long-term care costs on personal assets, the process routine including calculations to account for hypothetical tax consequences resulting from a sale of a portion of the personal assets to pay the long-term care costs.

2. The computer program of claim 1 wherein the process routine is adapted and configured to perform calculations that account for hypothetical unrealized investment opportunity resulting from an absence of the portion of the personal assets due to the sale of the portion of the personal assets.

3. The computer program of claim 2 wherein the process routine is adapted and configured to determine the economic impact of the future long-term care costs on the personal assets as a function of time and to output the economic impact for at least a first and second point in time.

4. The computer program of claim 3 wherein the second point in time represents a point in time after the long-term care costs have hypothetically ceased being incurred,

the economic impact for the second point in time being greater than the economic impact at the time the long-term care costs cease due to the unrealized investment opportunity calculations.

5. The computer program of claim 1 wherein the economic impact represents an insured economic impact and the portion of the personal assets is a first portion and wherein the process routine adapted and configured for using the stored data to determine the insured economic impact includes calculations to account for periodic premium payments and monetary insurance benefits received, and further comprising a process routine adapted and configured for using the stored data to determine an uninsured economic impact of the long-term care costs on the personal assets, the process routine adapted and configured for using the stored data to determine an uninsured economic impact including calculations to account for hypothetical tax consequences resulting from a sale of a second portion of the personal assets to pay the long-term care costs, the uninsured economic impact being independent of any periodic premium payments and any monetary insurance benefits received.

6. The computer program of claim 5 wherein the hypothetical tax consequences are accounted for in the process routine adapted and configured for using the stored data to determine the insured economic impact by assuming that any long-term care costs in excess of the monetary insurance benefits and all of the insurance premiums are paid for by the sale of the first portion of the personal assets and wherein the process routine

adapted and configured for using the stored data to determine the insured economic impact includes calculations to account for hypothetical unrealized investment opportunity resulting from an absence of the first portion of the personal assets due to the sale the first portion of the personal assets and the process routine adapted and configured for using the stored data to determine the uninsured economic impact includes calculations to account for hypothetical unrealized investment opportunity resulting from an absence of the second portion of the personal assets due to the sale of the second portion of the personal assets.

7. The computer program of claim 5 further comprising an output routine for facilitating the graphical display of the insured and uninsured economic impacts in a manner allowing proportional visualization of the magnitudes thereof.

8. A computer program comprising:

a storage routine adapted and configured to store, in a storage device, user-controlled data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options;

a process routine adapted and configured for using the stored data to determine an insured economic impact of the long-term care costs on personal assets, the process routine adapted and configured for using the stored data to determine the insured economic impact including calculations of a first portion of the personal assets

hypothetically sold to pay the long-term care costs and calculations to account for periodic premium payments and monetary insurance benefits received; and

a process routine adapted and configured for using the stored data to determine an uninsured economic impact of the long-term care costs on the personal assets, the process routine adapted and configured for using the stored data to determine the uninsured economic impact including calculations of a second portion of the personal assets hypothetically sold to pay the long-term care costs, the uninsured economic impact being independent of any periodic premium payments and any monetary insurance benefits received.

9. The computer program of claim 8 further comprising an output routine for facilitating the graphical display of the insured and uninsured economic impacts in a manner allowing proportional visualization of the magnitudes thereof.

10. The computer program of claim 8 wherein the process routine adapted and configured for using the stored data to determine the insured economic impact includes calculations to account for hypothetical unrealized investment opportunity resulting from the hypothetical sale of the first portion of the personal assets and wherein the process routine adapted and configured for using the stored data to determine the uninsured economic impact includes calculations to account for hypothetical unrealized investment

opportunity resulting from the hypothetical sale of the second portion of the personal assets.

11. The computer program of claim 10 wherein the process routine adapted and configured for using the stored data to determine the insured economic impact includes calculations to account for hypothetical tax consequences resulting from the sale of the first portion of the personal assets and wherein the process routine adapted and configured for using the stored data to determine uninsured economic impact includes calculations to account for hypothetical tax consequences resulting from the sale of the second portion of the personal assets.

12. The computer program of claim 11 wherein the hypothetical tax consequences are accounted for in the process routine adapted and configured for using the stored data to determine the insured economic impact by assuming that any long-term care costs in excess of the monetary insurance benefits and all of the insurance premiums are paid for by the sale the first portion of the personal assets.

13. The computer program of claim 11 wherein the process routine adapted and configured for using the stored data to determine the uninsured economic impact determines the uninsured economic impact as a function of time and is configured to output the uninsured economic impact for at least first and second points in time, and wherein the process routine adapted and configured for using the stored data to

determine the insured economic impact determines the insured economic impact as a function of time and is configured to output the insured economic impact for at least the first and the second points in time.

14. The computer program of claim 13 wherein the second point in time represents a point in time after the long-term care costs have hypothetically ceased being incurred, the insured and uninsured economic impacts for the second point in time being greater than the insured and uninsured economic impacts respectively at the time the long-term care costs cease due to the unrealized investment opportunity calculations.

15. The computer program of claim 13 further comprising an output routine for facilitating graphical display of the insured and uninsured economic impacts in a manner allowing proportional visualization of the magnitudes thereof.

16. A computer program comprising:

a storage routine adapted and configured to store, in a storage device, user-controlled data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options; and

a process routine adapted and configured for using the stored data to determine an economic impact of the future long-term care costs on personal assets as a function of time, the process routine being configured to output the economic impact for at least

first and second points in time and to calculate a portion of the personal assets hypothetically sold to pay the long-term care costs at each of the points in time.

17. The computer program of claim 16 wherein the economic impact represents an insured economic impact and each portion of the personal assets is a first portion, the process routine adapted and configured for using the stored data to determine the insured economic impact including calculations to account for periodic premium payments and monetary insurance benefits received, the computer program further comprising a process routine adapted and configured for using the stored data to determine an uninsured economic impact of the long-term care costs on the personal assets as a function of time, the process routine adapted and configured for using the stored data to determine the uninsured economic impact being configured to output the uninsured economic impact for at least the first and second points in time and to calculate a second portion of the personal assets hypothetically sold to pay the long-term care costs at each of the points in time, the uninsured economic impact being independent of any periodic premium payments and any monetary insurance benefits received.

18. The computer program of claim 17 wherein the process routine adapted and configured for using the stored data to determine the insured economic impact includes calculations to account for hypothetical tax consequences resulting from the sale of the first portion of the personal assets and wherein the process routine adapted and

configured for using the stored data to determine the uninsured economic impact includes calculations to account for hypothetical tax consequences resulting from the sale of the second portion of the personal assets.

19. The computer program of claim 18 wherein the hypothetical tax consequences are accounted for in the process routine adapted and configured for using the stored data to determine the insured economic impact by assuming that any long-term care costs in excess of the monetary insurance benefits and all of the insurance premiums are paid for by the sale of the first portion of the personal assets.

20. The computer program of claim 18 wherein the process routine adapted and configured for using the stored data to determine the insured economic impact includes calculations to account for hypothetical unrealized investment opportunity resulting from the sale of the first portion of the personal assets and wherein the process routine adapted and configured for using the stored data to determine the uninsured economic impact includes calculations to account for hypothetical unrealized investment opportunity resulting from the sale of the second portion of the personal assets.

21. A method comprising:

acquiring user-controlled data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options; and

determining an economic impact of the long-term care costs on personal assets based on the acquired data, the determination including performing calculations to account for hypothetical tax consequences resulting from a sale of a portion of the personal assets to pay the long-term care costs.

22. A method of advising a person comprising using the method of claim 21 in an effort to persuade the person to purchase long-term care insurance.

23. A method comprising:

acquiring user-controlled data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options;

determining an insured economic impact of the long-term care costs on personal assets based on the acquired data, the determination of the insured economic impact including performing calculations of a first portion of the personal assets hypothetically sold to pay the long-term care costs and calculations to account for periodic premium payments and monetary insurance benefits received; and

determining an uninsured economic impact of the long-term care costs on the personal assets based on the acquired data, the determination of the uninsured economic impact including performing calculations of a second portion of the personal assets hypothetically sold to pay the long-term care costs, the uninsured economic impact being independent of any periodic premium payments and any monetary insurance benefits received.

24. The method of claim 23 wherein the steps of determining an insured economic impact and of determining an uninsured economic impact are generally made simultaneously.

25. A method of advising a person comprising using the method of claim 23 in an effort to persuade the person to purchase long-term care insurance.

26. A method comprising:

acquiring user-controlled data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options; and

determining an economic impact of the future long-term care costs on personal assets as a function of time based on the stored data, the determination of the economic impact including performing calculations of a portion of the personal assets hypothetically sold to pay the long-term care costs for at least first and second points in time.

27. A method of advising a person comprising using the method of claim 26 in an effort to persuade the person to purchase long-term care insurance.

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TRANSMITTAL LETTER
(General – Patent Pending)

Docket No.
66705-4906

In Re Application Of:
LEISLE, Ralph D.

RECEIVED
AUG 6 - 2004
GROUP 3600

Serial No.	Filing Date	Examiner	Group Art Unit
09/638,779	August 15, 2000	SHIH, Sally	3624

Title:
COMPUTER PROGRAM AND METHOD FOR DETERMINING THE ECONOMIC IMPACT OF LONG-TERM CARE

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS

Transmitted herewith is:

1.) Notice of Appeal
2.) Copy of Notice of Appeal for Deposit Account Processing of fee
4.) Return Postcard

in the above identified application.

☐ No additional fee is required.

☐ A check in the amount of $______ is attached.

☒ The Commissioner is hereby authorized to charge and credit Deposit Account No. 20-0823 as described below. A duplicate copy of this sheet is enclosed.

- ☒ Charge the amount of $165.00 for filing of the Notice of Appeal (small entity).
- ☒ Credit any overpayment.
- ☒ Charge any additional fee required.

Signature

Dated: July 30, 2004

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I certify that the document and fee is being deposited on July 30, 2004 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to "Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)].

Signature of Person Mailing Correspondence

Clyde L. Smith, Reg. No. 46,292

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NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES	Docket Number (Optional) 16705-4906

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GROUP 3600

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]"
on July 30, 2004.

Signature ________

Typed or printed name Clyde L. Smith, No. 46,292

In re Application of LEISLE, Ralph D.	
Application Number 09/638,779	Filed August 15, 2000
For COMPUTER PROGRAM AND METHOD FOR DETERMINING THE ECONOMIC IMPACT OF LONG-TERM CARE	
Group Art Unit 3624	Examiner SHIH, Sally

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 1.17(b)) $ 330.00.

☒ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: $ 165.00.

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☒ The Commissioner is hereby authorized to charge the fee of $165.00 in this application to Deposit Account No. 20-0823. I have enclosed a duplicate copy of this sheet.

☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 20-0823. I have enclosed a duplicate copy of this sheet.

☐ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

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I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).

☒ attorney or agent of record.

☐ attorney or agent acting under 37 CFR 1.34(a).
Registration number if acting under 37 CFR 1.34(a)________.

Signature

Clyde L. Smith, No. 46,292
Typed or printed name

July 30, 2004
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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